

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/888,940
Filing Date: June 25, 2001
Applicant(s): GRIBB et al.
Title: DELAY LINE ANODES

Group Art Unit: 2853
Examiner: Nguyen, Judy
Atty. Docket: 66054.002

PETITION UNDER 37 CFR §1.181(a)(1) TO
WITHDRAW PREMATURE FINAL REJECTION
(37 CFR §1.113(a); MPEP 706.07(c))

Group Director, Group 2853
Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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This petition is filed in the above-noted application to withdraw the finality of the May 16, 2005 Office Action.

As per MPEP 1002.02(c), it is understood that this Petition is to be decided by the Group Director of Group Art Unit 2853. If this understanding is incorrect, please forward to the Office of Petitions or the other responsible entity.

1. *Petition Fee (37 CFR §1.17(h))*: No fee is required for this Petition.
2. *Timing of Petition (37 CFR §1.181(f))*: This Petition is filed within two months of the mailing date of the Final Office Action wherein the final rejection is set forth.

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3. **Prior Request for Reconsideration (37 CFR §1.181(c)):** The Applicant requested reconsideration in a Response submitted to the Examiner, which included a draft version of this Petition. A copy of the Response is attached.

4. **Statement of Facts (37 CFR §1.181(b)):** The facts are as follows.

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a. **The Office Action of January 26, 2005** set forth the following rejections:

a.(1) Claims 1-5, 7-8, and 10-11 under 35 USC §112(1) and (2)

a.(2) Claims 1, 3-7, 10, 12, 24, 26, 28, 39-44, and 46-47 under USC §103(a) view of *Friedman et al.* ("Multilayer Anode with Crossed Serpentine Delay Lines for High Spatial Resolution Readout of Microchannel Plate Detectors") and U.S. Patent 3,581,091 to *Meijer*. Here, the USPTO argued (among other things) that FIG. 2 of *Meijer* illustrates and suggests adjustably respaceable anodes (pages 4-5 of January 26, 2005 Office Action).

a.(3) Claims 2, 25, 27, and 48-49 under USC §103(a) view of *Friedman et al.* ("Multilayer Anode with Crossed Serpentine Delay Lines for High Spatial Resolution Readout of Microchannel Plate Detectors"), U.S. Patent 3,581,091 to *Meijer*, and U.S. Patent 3,359,421 to *Perez-Mendez et al.*

b. **The Response of March 9, 2005** set forth extensive arguments against the foregoing rejections without amending the claims. In particular, it was argued that the §103 rejections of claims 1, 3-7, 10, 12, 24, 26, 28, 39-44, and 46-47 (wherein claims 1, 24, and 39 are independent claims) were incorrect because:

b.(1) Regarding claims 1, 3, 6, 24, 26, 39, 42, 43, and 47, while the January 26, 2005 Office Action alleged that *Meijer's* "anodes" 2 and 5 were spaced to be adaptably adjustable, *Meijer* does not in fact show or state this. Rather, column 1 lines 16-22 and column 2 lines 24-37 of *Meijer* explicitly state that the

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illustrated anodes are spaced by a fixed distance equal to the diameter of the anodes. It was further noted that such spacing was necessary in *Meijer* for the anodes to be operable. Thus, *Meijer* does not in fact provide any motivation to modify *Friedman* to attain the claimed matter. See pages 15-16 of the March 9, 2005 Response.

- b.(2) Further regarding claims 1, 3, 6, 24, 26, 39, 42, 43, and 47, the primary reference *Friedman* starts with a pair of separate anodes, but then bonds the two anodes together at a fixed distance precisely to avoid variability in spacing. Thus, the secondary reference *Meijer* could not motivate an ordinary artisan to provide adjustable spacing between anodes because such a modification is contrary to the purposes of *Friedman*. See page 17 of the March 9, 2005 Response.
- b.(3) Regarding dependent claims 4-5 and 40-41, passages of *Friedman* and *Meijer* were cited to show that the two anodes discussed therein were not in fact identical or interchangeable, and thus the references did not disclose or suggest the arrangement claimed in claims 4-5 and 40-41. See page 17 of the March 9, 2005 Response.
- b.(4) Regarding dependent claims 10 and 44, passages of *Friedman* and *Meijer* were cited to show that the two anodes discussed therein were not made of flexible material, and thus the references did not disclose or suggest the arrangement claimed in claims 10 and 44. See page 17 of the March 9, 2005 Response.
- c. The *Final Office Action of May 16, 2005* maintained the §103 rejections, reproducing them verbatim and also providing the following response to Applicant's arguments at page 6:
- ... the arguments regarding to the 103 rejection have been found not persuasive.

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First of all, the applicants argued that Meijer does not teach or suggest adjustable spacing between the delay line anodes. The examiner responds that, as broadly interpreted, the claims are understood as the anodes adaptably mounted in a space, wherein the length of the space between the anodes is adjustable. As clearly shown in FIG. 1, since there is no fix structure between the anodes, an anode is free to relatively move from the other. In other words, the space between the anodes can be adjusted.

As regarding to arguments relating to claims 4-5 and 40-41, the applicants argued that neither reference offers any disclosure or suggestion of the first and second delay line anodes are identical. In response, the examiner cites that Friedman in FIG. 1 discloses two identical delay lines arranged orthogonal on different planes.

As regarding to arguments relating to claims 10 and 44, the applicants argued that Friedman does not disclose the use of flex circuit material. However, the applicants did not show why Rt/duroid 6010 ceramic-filled PTFE dielectric is not a flex material. In addition, with the thickness disclosed in the cited prior art, the anode boards are believed to be bendable (flexible). Moreover, the bonding of the anodes on the base plate only means that the whole structure is not bendable, but does not mean that the anode boards, themselves, are not bendable (flexible).

The final rejection is premature because the Applicant's arguments regarding claims 1, 3-6, 24, 26, 39-43, and 47 – items b.(1)-b.(3) above – are not addressed: the Applicant argued why *Meijer* does not in fact depict adjustably respaceable anodes (citing specific passages of *Meijer* which state this point), and why one would not be motivated to modify *Friedman* to use such an arrangement, *but the Final Office Action is not seen to contain any response to these arguments. We need to know why our arguments were found to be factually or legally deficient, and we need an opportunity to effectively respond.* MPEP 706.07 states that

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. . . . The examiner should never lose sight of the fact that in every case the applicant is

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entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

See also MPEP 707.07(f), Answer All Material Traversed ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it"); also see Examiner Notes for PTO form paragraphs 7.37 and 7.38 (as reproduced in MPEP 707.07), which require that all relevant arguments by the Applicant be addressed, as well as MPEP 706.07 under "Statement of Grounds" ("the final rejection . . . also should include a rebuttal of any arguments raised in the applicant's reply"). The Final Office Action does not meet the requirements of the foregoing provisions. It simply states that FIG. 1 (presumably of *Meijer*?) shows adjustably respaceable anodes - but our March 9, 2005 Response set out several points showing that this is not in fact the case. *Why are these points disagreed with?* Unless we know why, we cannot address the Examiner's concerns.

As per 37 CFR §1.181(b), any facts requiring proof are set out in the form of declarations or exhibits accompanying this Petition.

5. **Action Requested (37 CFR §1.181(b)):** It is requested that the Final Office Action and the final rejection therein be withdrawn, and that any maintained rejections be reissued in a new, nonfinal Office Action which fully addresses the Applicant's arguments. If this relief is denied, it is then requested that the action taken provide the Applicant with the "full and fair hearing" noted by MPEP 706.07.

In Closing

If any questions regarding this petition or the application arise, please contact the undersigned attorney. Telephone calls are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

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For the Applicant,

ATTACHMENTS:

- Exhibits supporting facts to be proven
(37 CFR §1.181(b))

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